

A/ 9. (Amended) A method of protecting tin solderable surfaces, according to claim 1, wherein said complexing agent is selected from the group consisting of dicarboxylic acids and dibasic acids.

### REMARKS

Claims 1-11, 23-35, and 27-28 are pending in the application. Each of the pending claims defines an invention that is novel and unobvious over the cited art. Favorable consideration of this case is respectfully requested.

Claim 9 was rejected under 35 U.S.C. § 112(2<sup>nd</sup>) as being indefinite for including "complexing agents" in the Markush group recitation defining complexing agent. Claim 9 is hereby amended to delete the objectionable recitation.

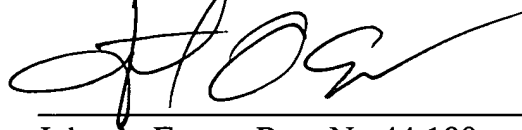
Claims 1-11, 23-25, and 27-28 were rejected under 35 U.S.C. § 102(e) as being anticipated by Henderson (6,217,671). The authors of the reference patent are Donald W. Henderson and James Spalik. As attested in the Affidavit submitted herewith, Henderson and Spalik are co-inventors of the present invention. At the time of invention, the reference patent, and the present invention were under obligation of assignment to International Business Machines Corporation, the assignee of the present invention. In view of the common authorship, US 6,217,671, is disqualified as a reference under 35 U.S.C. § 102(e) (MPEP § 715.01(c)).

In view of the above, consideration and allowance are, therefore, respectfully solicited.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication, including any extension fees or fees for the net addition of claims, to Deposit Account No. 22-0185.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'JAE', is written over a horizontal line.

John A. Evans, Reg. No 44,100  
Connolly, Bove, Lodge & Hutz LLP  
1990 M Street, N.W.  
Washington, D.C. 20036-3425  
Telephone: 202-331-7111

Date: February 1, 2002